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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/529,847	06/13/2005	Jun Sakamoto	IPE-052	1538
20374 7590 12/22/2008 KUBOVCIK & KUBOVCIK SUITE 1105 1215 SOUTH CLARK STREET ARLINGTON, VA 22202				
EXAMINER				
MESH, GENNADIY				
ART UNIT		PAPER NUMBER		
1796				
MAIL DATE		DELIVERY MODE		
12/22/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Advisory Action  
Before the Filing of an Appeal Brief**

**Application No.**

10/529,847

**Applicant(s)**

SAKAMOTO ET AL.

**Examiner**

GENNADIY MESH

**Art Unit**

1796

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 10 December 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.  
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 1, 8 and 13-19.  
Claim(s) withdrawn from consideration: 20-52.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☒ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

/Vasu Jagannathan/  
Supervisory Patent Examiner, Art Unit 1796

/Gennadiy Mesh/  
Examiner, Art Unit 1796

Continuation of 11, does NOT place the application in condition for allowance because: Applicant's arguments filed on December 10, 2008 were found unpersuasive for following reasons:

Applicant's arguments based on statement that "Office has not shown that Aoyama, alone or as modified by Naylor and Kato as proposed in the Final Action, discloses a polyester resin composition which meets all of the limitations of the rejected claims. Specifically, the Office has not shown that Aoyama, alone or modified by Naylor and Kato as proposed by the office, discloses a composition that does not contain titanium-containing particles having an equivalent circular diameter of 1 micron or more or contains less than 100 titanium-containing particles per 0.02 mg of the composition having an equivalent circular diameter of 1 micron or more. This Argument based on data provided by Declaration under 37 C.F.R. 1.132 filed after Final rejection, without any reasons why this Declaration was not presented earlier. For this reason, Declaration was found untimely and will not be entered and considered. Therefore, Applicant argument based on Declaration filed on November 13, 2008 is unpersuasive.

In addition note, that rejection based on combination of references (Aoyama combine with Naylor and Kato in this case) is not anticipatory rejection and for this reason does not need disclosed all specific elements of Applicant's claimed subject matter, but rather should render claimed subject matter obvious to one of ordinary skill.

In this case, Aoyama recognized importance of small particle sizes less than 3 micron in order "to achieve good slipperiness and adhesiveness at the time of lamination" - see column 6, lines 1-6. Thus, Aoyama provide rationale to one of ordinary skill to reduce particle size less than 3 micron in order to achieve "good slipperiness and adhesiveness" of the composition.

In addition Applicant was advised to provide factual data in order to show unexpected benefits of the composition, wherein particles, having diameter is larger than 1 micron present in specific amount claimed by Applicant (see Advisory mailed on January 4, 2008) compare with composition disclosed by Aoyama as the most closes prior art of the record. Sop far no such results were presented by Applicant.

Based on reasons above, Applicant's arguments were found unpersuasive..

/GM/